## REMARKS

Claims 1-50 are pending. Claims 9-11 and 14-50 are withdrawn. Applicants have amended Claim 1. The amendments add no new matter and are fully supported by the specification and claims as originally filed. Support for the amendments can be found, for example, in paragraphs [0032] and [0048]-[0050], and elsewhere throughout the specification and claims as originally filed.

Claims 1-8 and 12-13 stand rejected by the Examiner. Applicants respond below to the specific rejections set forth in the Office Action mailed July 10, 2008. For the reasons set forth below, Applicants respectfully traverse.

*Rejection Under 35 U.S.C. § 102(e)*

The Examiner has rejected Claims 1-7 and 12-13 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application Publication No. US 2002/0086065 to Katz. According to the Examiner, Katz teaches a method of decreasing insulin resistance comprising the oral administration of chromium picolinate (at a daily dose of 1000 μg of chromium) and ibuprofen (a NSAID) as a single tablet. According to the Examiner, although Katz does not teach that the chromium picolinate antagonizes the insulin resistance increasing activity of the ibuprofen, this property is inherent to the composition and is necessarily present. Accordingly, the Examiner argues that Katz anticipates the subject matter of Claims 1-7 and 12-13.

Applicants respectfully traverse. To be anticipatory under 35 U.S.C. § 102, a reference must teach each and every element of the claimed invention. *See Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). "Invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference...There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991).

Katz does not anticipate Claims 1-7 and 12-13. As amended, Claims 1-7 and 12-13 recite the step of "identifying an individual receiving a dose of a drug that induces insulin resistance." Katz does not teach the step of identifying an individual receiving a dose of a drug that induces insulin resistance, as required by Applicants' claims. Katz relates to the use of chromium and

chromium complexes to treat Polycystic Ovary Syndrome (PCOS). (See, Katz, at paragraph [0003]). Katz does not teach the step of identifying an individual receiving a dose of a drug that induces insulin resistance, as required by Applicants' claims. Rather, the individuals in Katz are identified as having PCOS. Katz teaches treatment of PCOS by administering chromium (*e.g.*, in the form of chromium complexes). Katz states that NSAIDs, such as ibuprofen, inhibit the cyclooxygenase pathway leading to prostaglandin synthesis, thereby facilitating the absorption of the chromium complexes. (Id. at paragraph [0064]). In other words, Katz teaches that, in some embodiments, a subject identified as having PCOS may be administered a composition that includes both chromium and ibuprofen. These subjects have not been identified as receiving a drug that induces insulin resistance, however. Accordingly, Katz fails to meet this limitation of Applicants' claims.

Because Katz fails to teach each and every limitation of Claims 1-7 and 12-13, it cannot be anticipatory under 35 U.S.C. § 102(e). Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e).

*Rejection Under 35 U.S.C. § 103(a)*

The Examiner has rejected Claim 8 under 35 U.S.C. § 103(a), as allegedly being unpatentably obvious over Katz in view of Goodman and Gillman's, The Pharmacological Basis of Therapeutics, Eighth Ed. According to the Examiner, Katz teaches all of the limitations of Claim 8, except the parenteral administration of chromium picolinate and ibuprofen. The Examiner states that Goodman and Gillman's teaches that parenteral administration of drugs is commonly used to overcome disadvantages of oral administration, and maintains that as such, it would have been obvious to the skilled artisan to administer the composition of Katz parenterally. Applicants respectfully traverse.

It is well settled that the Examiner "bears the initial burden of presenting a *prima facie* case of unpatentability..." *In re Sullivan*, 498 F.3d 1345 (Fed. Cir. 2007). To establish a *prima facie* case of obviousness, the Examiner must establish that the prior art reference (or references when combined) teach or suggest all of the claim limitations: "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (CCPA 1970); *see also M.P.E.P. § 2143.03*. Although prior art

reference (or references when combined) need not teach or suggest all the claim limitations, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. The "mere existence of differences between the prior art and an invention does not establish the invention's nonobviousness." *Dann v. Johnston*, 425 U.S. 219, 230, 189 USPQ 257, 261 (1976). The gap between the prior art and the claimed invention may not be "so great as to render the [claim] nonobvious to one reasonably skilled in the art."*Id. KSR*, 127 S. Ct. at 1731 (emphasis added). Further, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091 (Fed. Cir. 1986); *see also M.P.E.P. § 2143.02.*

As discussed with reference to the rejection under 35 U.S.C. § 102(e), Katz does not teach the identification of a subject receiving a drug that induces insulin resistance, as recited in Applicants' presently amended claims. Rather, Katz describes the administration of chromium to individuals suffering from PCOS, and suggests that the co-administration of ibuprofen with chromium would advantageously facilitate the uptake of chromium. As such, it is clear that the skilled artisan would not be led to the identification of individuals taking ibuprofen and administering chromium to those individuals in order to inhibit the development of drug-induced insulin resistance. The teachings of Goodman and Gillman's are relied upon by the Examiner solely for its teachings regarding parenteral administration, and the reference does not fill the gaps in the teachings of Katz, in order to establish a *prima facie* case of obviousness.

Furthermore, the combined teachings of Katz sand Goodman and Gillman's do not provide the skilled artisan with a reasonable expectation of success. Specifically, Katz suggests that ibuprofen and other NSAIDs facilitate the uptake of chromium, and that as such, the combination is useful for the treatment of PCOS. Katz is completely silent regarding the induction of insulin resistance as a result of NSAID administration. Because Katz is silent regarding the induction of insulin-resistance observed with NSAIDs, the reference cannot provide a reasonable expectation of successfully inhibiting its development, by identifying a subject taking an NSAID and administration of chromium to the subject. As mentioned above, the teachings of Goodman and Gillman are limited such that the reference does not fill the gaps in the teachings of Katz, in order to establish a *prima facie* case of obviousness.

In view of the above, Katz in combination with Goodman and Gillman's, does not render Claim 8, or 1-7 and 12-13 *prima facie* obvious under 35 U.S.C. § 103(a). As such, Applicants respectfully request reconsideration and withdrawal of the rejection.

*No Disclaimers or Disavowals*

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

## CONCLUSION

In view of the above amendments and remarks, Applicants respectfully maintain that the claims are patentable and request that they be passed to issue. Applicants invite the Examiner to call the undersigned if any remaining issues may be resolved by telephone.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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